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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/620,759 Confirmation No. : 9152
Applicant : Manfred GALLE, et al.
Filed : July 17, 2003
TC/A.U. : 1651
Examiner : DAVIS R A
Docket No. : 029300.52497US
Customer No. : 23911
Title : Microbial Enzyme Mixture Useful to Treat Digestive Disorders

REPLY TO OFFICE ACTION

Mail Stop: Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a response to the Office Action mailed September 13, 2004 in the above-identified patent application.

Responsive to the requirement for restriction, Applicants hereby elect the composition claims of Group I, namely claims 1-13, for examination in the instant application. This election is made with traverse.

The requirement for restriction is traversed because the alleged grounds given in the Office Action to justify the restriction are based on an erroneous premise. The restriction is allegedly justified on grounds that the process of claims 14-18 could supposedly be practiced with a product other than the composition of claims 1-13. By way of explanation, the Office Action states that "materially different products could be used to inhibit maldigestion such as cultures of lactobacillus, bromelain or ginger extract."

MPEP § 806.05(h) states that restriction may be required if a process of use **as claimed** can be practiced with another materially different product. In this case, method claim 14 is dependent from composition claim 1 and by its terms expressly requires administration of the composition according to claim 1. Thus, the process **as claimed** requires use of the claimed composition. All that the Office Action establishes is that other substances can be used for the same

general purpose, but this is not the same as establishing that the process as **claimed** can be practiced with a materially different product. The process "as claimed" is more specific than just inhibition of maldigestion. The process "as claimed" requires the use of the composition of claim 1. The attempted restriction thus fails to satisfy the explicit requirements of MPEP § 806.05(h). Consequently, the requirement for restriction is improper and cannot stand.

Favorable action on the application is earnestly solicited.

If there are any questions regarding this response or the application in general, a telephone call to the undersigned at 202-624-2845 would be appreciated since this should expedite the prosecution of the application for all concerned.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (Docket #029300.52497US).

Respectfully submitted,



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September 30, 2004

JDE/sjm

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